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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,009

01/30/2006

Serguei Sviridov

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EXAMINER

TUCKER, ZACHARY C

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

03/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
buta@oshaliang.com

Office Action Summary	Application No. 10/567,009	Applicant(s) SVIRIDOV ET AL.	
	Examiner Zachary C. Tucker	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>30Jan06</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1624

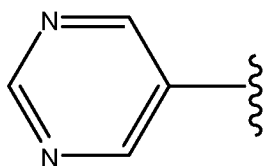
***Lack of Unity of Invention
~and~
Election of Species***

Restriction is required under 35 U.S.C. 121 and 372.

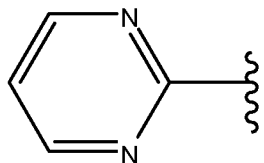
This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

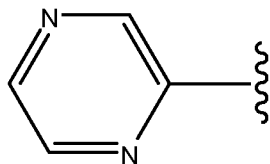
Group I, claims 1-9 (in part), 27 (in part) and 50 (in part), drawn to methods of use for compounds according to formulae (I), (II), and (Ia) wherein the six membered ring attached to the piperazinyl moiety has the following structure:



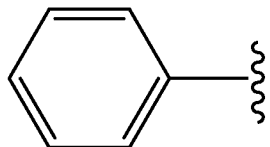
Group II, claims 1-9 (in part), 44 (not in part), and 50 (in part) drawn to methods of use for compounds according to formulae (I), (IV) and (Ia), wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



Group III claims 1-9 (in part), 36 (not in part), and 50 (in part), drawn to methods of use for compounds according to formulae (I), (III) and (Ia), wherein the six-membered ring attached to the piperazinyl moiety has the following structure:

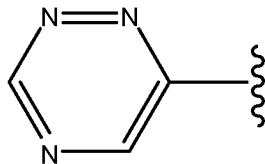


Group IV, claims 1-9 and 50 (all in part), drawn to methods of use for compounds according to formulae (I) and (Ia), wherein the six-membered ring attached to the piperazinyl moiety has the following structure:

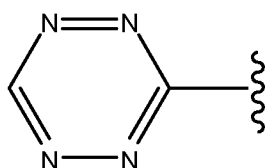


Art Unit: 1624

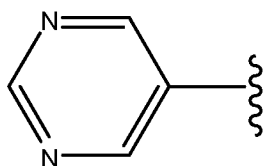
Group V, claims 1-9, 27 and 50 (all in part), drawn to methods of use for compounds according to formulae (I), (II) and (Ia), wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



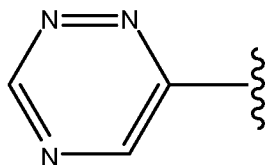
Group VI, claim 27, drawn to methods of use for compounds according to formula (II), wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



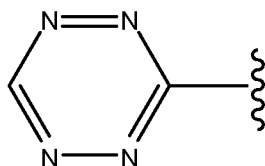
Group VII, claims 10 (in part), 11-26 (not in part), 28, 46-49 and 51 (all in part), drawn to compounds of formulae (II) and (Ia), and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



Group VIII, claims 10, 28, 46-49 and 51 (all in part), drawn to compounds of formula (II), and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:

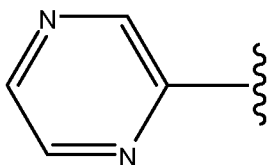


Group IX, claims 10 and 28 (both in part), drawn to compounds of formula (II), and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:

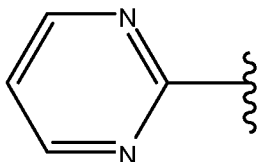


Group X, claims 29-35 and 37 (not in part); claims 46-49 and 51 (all in part), drawn to compounds of formulae (III) and (Ia) and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:

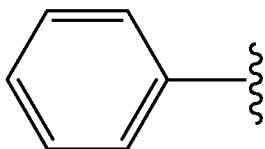
Art Unit: 1624



Group XI, claims 38-43 and 45 (not in part); claims 46-49 and 51 (all in part), drawn to compounds of formulae (IV) and (Ia), and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



Group XII, claims 46-49 and 51, drawn to compounds of formula (Ia), and a pharmaceutical composition comprised thereof, wherein the six-membered ring attached to the piperazinyl moiety has the following structure:



The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The inventions identified above are non-related and do not overlap in scope, thus, the prior art applicable to one of the inventions is not likely to be applicable to another invention.

This Requirement is Further Set Forth as Follows:

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must

Art Unit: 1624

also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species and invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) **identification of the claims encompassing the elected invention and species.**

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

This Requirement is Subject to the Following Conditions:

The examiner has required restriction between compounds and pharmaceutical compositions, and method of use claims. Where applicant elects claims directed to compounds, and a compound claim is subsequently found allowable, withdrawn method of use claims that depend from or otherwise include all the limitations of the allowable compound claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Method of use claims that depend from or otherwise include all the limitations of the patentable compound will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.** Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the compound claims and the compound and composition claims and method of use claims will be withdrawn, and the rejoined method of use claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.

Art Unit: 1624

Until an elected compound claim is found allowable, an otherwise proper restriction requirement between compound claims/pharmaceutical composition claims and method of use claims may be maintained. Withdrawn method of use claims that are not commensurate in scope with an allowed compound claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the method of use claims should be amended during prosecution either to maintain dependency on the compound claims or to otherwise include the limitations of the compound claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Monday to Friday from 9:00am to 5:00pm. If Attempts to reach the examiner are unsuccessful, contact the examiner's supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

/Zachary C. Tucker/
Primary Examiner
Art Unit 1624